

**REMARKS**

The above-listed claim cancellations along with the following remarks are fully responsive to the final Office Action set forth above. By this Amendment, claims 1-21, 35, and 40-55 are cancelled. New claims 61-81 are added. After entry of this Amendment, claims 22-34, 36-39, and 56-81 are pending.

The present invention provides infrared-sensitive compositions, and printing plate precursors comprising a substrate and an infrared-sensitive composition coated on the substrate. The infrared-sensitive composition of the present invention comprises a polymeric binder consisting of a polymer or mixture of polymers having a weight-average molecular weight in the range of 10,000 to 1,000,000 g/mol, with the proviso that the total acid number of said polymeric binder is 70 mg KOH/g or less. The infrared-sensitive composition also comprises a free radical polymerizable system. The free radical polymerizable system consists of a polymerizable component, and an initiator system having a compound capable of absorbing infrared radiation, a compound capable of producing radicals, and a carboxylic acid.

Claims 1-8, 10-14, and 46-55 were directed to an embodiment featuring a recited carboxylic acid. Claims 1-8, 10-14, and 46-55 are cancelled by this Amendment in order to expedite prosecution. The present claim cancellations are not a disclaimer of scope of the claimed invention, and Applicants reserve the right to pursue, by way of a continuation application, claims directed to the embodiments of cancelled claims 1-8, 10-14, and 46-55.

New claims 61-81 depend from previously submitted claims 22 and 38, and are fully supported by the specification. Claims 61-81 are directed to alternative embodiments of the present invention. As claims 61-81 depend from claims previously considered by the Examiner, entry and consideration of claims 61-81 would not impose a significant burden. Entry of new claims 61-81 is therefore requested.

**Claim Rejections – 35 U.S.C. § 112**

The Examiner rejected claims 1-8, 10-14, 22-34, 36-39 and 46-60 under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-8, 10-14, and 46-55 are now cancelled. With respect to claims 22-34, 36-39, and 56-60, the rejection is respectfully traversed.

The Examiner stated that all independent claims recite a polymeric binder (A) representing 20-80% of an infrared-sensitive composition, but that at 80% by weight the

polymeric binder is beyond the limits allowed if components (B)(1), (B)(2), and (B)(3) are present at their respective recited minimums. The Examiner concludes that the claims are confusing and are therefore indefinite.

Applicants acknowledge that if the components (A) and components (B) are exclusive from one another and if components (B)(1), (B)(2), and (B)(3) are present at their respective recited minimums, then the polymeric binder (A) cannot be present at its recited maximum. However, this fact alone does not make the claims indefinite. Although such claim structure may not be preferable, a similar claim structure has been held to be sufficiently definite for the purposes of § 112 by the Court of Customs and Patent Appeals ("CCPA").

The CCPA considered a decision by the Patent Office Board of Appeals ("Board") upholding an examiner's indefiniteness rejection in *In Re Kroekel*, 183 USPQ 610 (CCPA 1974), a copy of which is attached hereto for the Examiner's convenience. The claim at issue in *Kroekel* recited percentage ranges for a composition comprising several components. A total percentage of over 100% would be obtained if the maximum amount from one range was selected together with the minimum amounts from ranges specified for the remaining components. The examiner rejected the claim for indefiniteness, and the Board upheld the rejection. The CCPA reversed, stating "We find that one having ordinary skill in this art would have no difficulty ascertaining the subject matter encompassed within the scope of the appealed claims." *Id.* at 612. See also M.P.E.P. § 2173.05(c)(II).

The Examiner further inquires whether any of the components (B) overlaps the binder (A). While the infrared-sensitive composition may contain other polymers, the term "binder" refers only to a polymer or mixture of polymers having a weight-average molecular weight in the range of 10,000 to 1,000,000 g/mol. The polymerizable component recited as component (B)(1) would not generally be considered as part of the polymeric binder described above. Where, for example, the polymerizable component is a free-radical polymerizable monomer or oligomer, its molecular weight will normally be significantly lower than 10,000 g/mol and would therefore not be considered as part of the binder.

Claims 22-34, 36-39, and 56-60 are not indefinite, and withdrawal of the rejection is requested.

At paragraph 5 of the Office Action, the Examiner rejected claim 54 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants respectfully submit that the Examiner intended

to reject claim 51, not claim 54, based on the comments of the Examiner regarding ---Q--- representing an optional bridge completing a five- or six-membered carbocyclic ring. No such language appeared in claim 54. Nevertheless, by this Amendment both claims 54 and 51 are cancelled, rendering the rejection moot.

The Examiner rejected claim 48 and claim 53 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 48 and 53 are cancelled by this Amendment, rendering the rejections moot.

#### **Claim Rejections – 35 U.S.C. § 102**

The Examiner rejected claims 1-8, 10-14, and 48-55 as unpatentable over EP 0 889 363 A1 of Weed, *et al.* ("Weed"). Claims 1-8, 10-14, and 48-55 are cancelled by this Amendment, rendering the rejections moot.

10/040,241  
Page 15

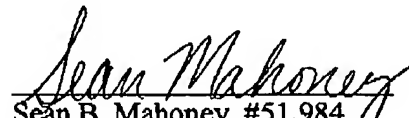
**Conclusion**

This Amendment places the application in condition for allowance, or in better condition for appeal, and entry of this Amendment and reconsideration of the application is requested. All claims are in condition for allowance, and a notice to that effect is respectfully solicited. If there are any outstanding issues remaining in this case after consideration of this Amendment, the Examiner is invited to call the undersigned attorney in order to expedite further prosecution.

Respectfully Submitted,

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